

Appl. No.: 10/009,453  
Response dated May 20, 2004  
Reply to Office action of March 24, 2004

### REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the foregoing amendments to the claims, and the remarks which follow.

Claims 9, 10, 12-16, and 18-24 are pending in this application.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claims 9, 10, 12-16, and 18-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ansmann et al. (WO 99/11235) in view of Miles (US 2,456,437). This rejection is respectfully traversed for the following reasons.

With respect to the Ansmann reference, it admittedly fails to contain any teaching or suggestion relating to the use of metal soap nanoparticles which are coated with a protective colloid, an emulsifier, or both. However, in an effort to overcome this admitted lack of teaching or suggestion, the Examiner relies upon the teachings of the Miles reference. Applicant respectfully submits, however, that the Examiner has failed to show the existence of any motivation on the part of one having ordinary skill in the art to want to combine the teachings of these two references. It is very well settled that an Examiner cannot establish obviousness through references describing various aspects of an Applicant's invention unless the Examiner also provides evidence of motivating force to compel a person skilled in the art to do what Applicant has done. See, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Applicant has argued on numerous occasions that the problem associated with

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Miles' teaching is that it is silent with respect to the potential for using organic materials to coat **inorganic** soap particles such as the claimed **metal** soap particles. The only soap particles referred to by the Miles reference, which are coated with its organic coating material, are sodium soaps of fatty acids. Thus, even a person of ordinary skill in the art having both the Ansmann and Miles references in front of them, would not necessarily be motivated to apply the organic material of the Miles reference onto the metal soaps of the Ansmann reference, since there is no teaching or suggestion in either reference which might motivate the routineer to want to do so. Moreover, there is no teaching or suggestion in either reference that the problem addressed by the Miles reference, i.e., elimination of dust particles, is also a problem experienced by metal soaps. Thus, in Applicant's opinion, the use of the organic materials of the Miles reference on the metal soaps of the Ansmann reference is far from obvious.

The Examiner, however, continues to argue that because the Miles reference fails to exclude coating inorganic soap particles, but instead refers to soap particles in general, it would thus be *prima facie* obvious to the routineer to want to coat inorganic soap particles as well. Applicant, however, would once again like to state that *prima facie* obviousness needs to be premised upon a teaching or suggestion found **within** a relied upon reference. *Prima facie* obviousness **CANNOT** be based on what a reference **doesn't teach or suggest**. Applicant respectfully submits that *prima facie* obviousness must be based upon what a prior art reference says, not on what it doesn't say. Moreover, with respect to the Examiner's contention in the current Office Action, page 5, first paragraph, that "...the metal soaps of Ansmann are nanoparticles and that all particles of such a small size range are subject to forming dust particles.", Applicant respectfully submits the Examiner has failed to provide any evidence in support of this contention. The Examiner

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appears to be arguing that metal soap nanoparticles **inherently** have dust particle issues. In response thereto, Applicant would like to note that it has been held that an Examiner, if relying upon a theory of inherency, must provide a basis in fact and/or technical reasoning to reasonably support a determination that an allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See, *In re Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990). Moreover, it has also been held that, "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." See, *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981). Unfortunately, the Examiner has failed to offer the requisite evidence in support of this belief.

Finally, Applicant would once again like to note that it is well settled in the law that the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an Applicant to prove conclusively that the Patent Office is wrong. See, *In re Soli*, 137 USPQ 797 (CCPA 1963). The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular modification is known and therefore obvious. Subjective opinions are of little weight in determining obviousness. See, *In re Wagner et al*, 152 USPQ 552 (CCPA 1967).

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

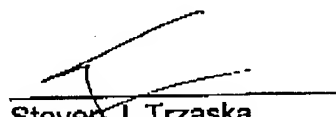
It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. A Notice of Allowance is therefore earnestly requested.

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The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,

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